



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): R. Ebright

Examiner: Hemant Khanna

Application No.: 10/526,323

Group Art Unit: 1654

Filed: February 28, 2005

Docket: 744-47 PCT/US

Confirmation No.: 6511

Dated: December 1, 2006

For: TARGET AND METHOD FOR
INHIBITION OF BACTERIAL
RNA POLYMERASE

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Date: December 1, 2006

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is in response to the Office Action mailed October 6, 2006, a reply to which is due December 6, 2006 with a request for a one-month extension of time submitted herewith.

In the Office Action, the Examiner has vacated the previous restriction (dated May 17, 2006), and a new election/restriction has been instituted. In particular, the Examiner submits that in view of the claims (claims 98-120) that were added in Applicant's amendment and response (dated June 13, 2006) to the previous restriction requirement, the shared technical feature in base claim 78 was reconsidered and a lack of a single inventive concept under PCT Rule 13.1 was determined by the Examiner. As a consequence, the Examiner has issued new restriction and election of species requirements on the amended claims.

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Under item 1 of the Office Action, the Examiner requires restriction under 35 U.S.C. §121 between one of the following groups, which the examiner states are not so linked as to form a single invention under PCT Rule 13.1:

Group I, claims 78-83, drawn to a peptide that differs in amino acid sequence from MccJ25 by an amino acid substitution, insertion, or deletion and that binds to bacterial RNAP;

Group II, claims 84-103, drawn to a method for identifying an agent that binds to bacterial RNAP comprising detecting at least one of the presence, extent, concentration-dependence, or kinetics of binding and inhibition of the agent to homologous RNAP; and

Group III, claims 104-120, drawn to a method for identifying an agent that binds to bacterial RNAP in competition with a reference compound and detects at least one of the presence, extent, concentration-dependence, or kinetics of binding and inhibition of the reference compound to homologous RNAP.

Under item 2 of the Office Action, the Examiner alleges that Groups I-III do not relate to a single general inventive concept because independent claim 78 is allegedly not free of the prior art. In particular, the Examiner states that the shared technical feature between Groups I-III (a peptide that differs in sequence from microcin J25 by an amino acid substitution, insertion or deletion and that binds to RNAP) is anticipated by Glinskii G. (WO 99/43338), and therefore is not a special technical feature.

Under item 3, the Examiner asserts that the application contains claims directed to more than one species that do not relate to a single general inventive concept under PCT Rule 3.1 because the shared technical feature (MccJ25 analogs that bind to RNAP) is allegedly anticipated

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by Glinskii, G. (WO 99/43338). The Examiner states that the species are as follows: the analogs in claims 78-83, RNAP (bacterial, eukaryotic, mutant) or a fragment thereof in claims 85, 88, 90, 99, 101, 117, 118, organisms selected from *Escherichia coli* or *Bacillus subtilis* in claims 86, 89, 99, 106, 117, and the activities in claims 96, 100. If Group I is elected, Applicant is required to elect a single species of a MccJ25 analog that is modified with a detectable group. If Group II or III is elected, Applicant is required to elect a single species of RNAP, a single organism and a single activity to which the claims would be restricted if no generic claim is finally held to be allowable.

In response, Applicant provisionally elects to prosecute Group II, claims 84-103, with traverse. Further, Applicant provisionally elects to prosecute, with traverse, intact bacterial RNAP, *Escherichia coli* as the organism, and RNA synthesis as the activity. The claims readable on the elected species in Group II are claims 84-103.

The Examiner asserts that independent claim 78 is anticipated by Glinskii, G. (WO 99/43339). However, Applicant submits that there is absolutely no relationship between independent claim 78 (which claims analogs of MccJ25), and the Glinskii reference (which claims compounds that block the assembly of bacterial RNA polymerase [a category of compounds that does not include MccJ25]). The Glinskii reference does not disclose MccJ25 analogs. Consequently, the Examiner's premise for the restriction is unfounded. Applicants respectfully request that the requirement for restriction to one of Groups I-III be withdrawn.

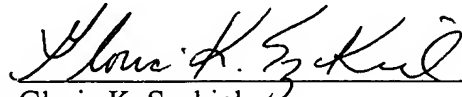
The Examiner further asserts that the species do not relate to a single general inventive concept because the shared technical feature is allegedly anticipated by Glinskii, G. (WO 99/43338). As set forth above, the Glinskii reference does not disclose MccJ25 analogs. Therefore, the shared technical feature is not anticipated by the Glinskii reference, and the

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Examiner's premise for the species election requirement is unfounded. Moreover, Applicant's specification discloses, in detail and with both text and figures, the basis for linking RNAP from different bacterial species to form a single inventive concept, and the basis that the same intended result would be achieved. This was, in fact, the point of defining bacterial RNAP secondary channel homologous sequences. See, for e.g., paragraphs [0027]-[0029] and FIGS. 1 and 2 of Applicant's published application. Applicants respectfully request that the species election requirement be withdrawn.

For these reasons, Applicants respectfully request that the requirement for restriction be withdrawn, and that consideration of all the claims on the merits be commenced. If the Examiner has any questions with respect to this matter, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,



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